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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,949	06/21/2001	Isabelle Afriat	209060US	2772

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EXAMINER	
JIANG, SHAOJIA A	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/884,949	AFRIAT, ISABELLE	
	Examiner	Art Unit	
	Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on July 23, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The following is the new ground(s) of rejection(s). All rejections on appeal are withdrawn and therefore moot.

Currently, claims 1-29 are pending in this application.

Claims 1-29 are examined on the merits herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Nadaud et al. (US 5567426, PTO-892).

Nadaud et al. discloses that the same water-in-oil emulsion or the same cosmetic composition comprising the same ingredients in the same amounts, as instantly claimed, is useful in the same method for treating, caring for, removing make-up from and/or cleansing the skin and/or hair comprising applying the same composition herein. See the specific and particular water-in-oil emulsion or cosmetic compositions disclosed in Example 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 at col.11-17;

e.g., the emulsion at Example 1 comprising (see col.11-12):

the aqueous phase (as taught at col.6 lines 31-38 of US 5567426) : water = 4+ (100 – the weight of all other non-water ingredients) =4+(100-36.26) = 67.74 g; propylene glycol (which meets claims 25 and 27 herein) = 4 + 20 g; glycerine (also known as glycerol which meets claim 26 herein) =0.4 + 2= 2.4 g; sodium chloride (or one electrolyte which meets claims 28-29 herein) =0.16 g; preservative dyes =0.6 g;

Thus, the total weight percent of the aqueous phase is 94.9% by adding up all the weight of ingredients in the aqueous phase which meets the limitation herein at least 80%.

Nadaud et al. discloses the use of the same emulsifier herein, dimethicone copolyol comprising oxyethylene groups (only) having formula at col.3 lines 17-36 when the ratio of groups C2H4O/C3H6O is 100:0, as product sold under the name "ABIL WE 09" (see col.3 lines 37-38) in the same amount, e.g., the emulsion at Example 1 comprising (see col.11-12): the weigh ratio of the oily phase = 0.5g per 100 g or 0.5% of

"ABIL WE 09" (which meets claim 5 herein) + 0.8g of silicone gum + 2.7 g of volatile silicone oil (which meets claim 22 herein) = 4 g.

Thus, the weigh ratio of the oily phase to the emulsifier "ABIL WE 09" is 4:0.5 = 8 which meets the limitations herein "greater than or equal to 5 or 8".

e.g., the emulsion at Example 3 comprising (see col.12-13):

water = 11.1+ (100 – the weight of all other non-water ingredients) =11.1+(100-40.2) = 70.9 g, which meets the limitations herein "at least 70% by weight water relative to the total weight of the composition".

the weigh percent of the oily phase = 0.6+0.2+1+3.4+5=10.2 g per 100 g or 10.2% which meets the limitations herein "oily phase is present in an amount ranging from 10% to 18% by weight" in claims 6 and 13herein.

Regarding the inherent property, the viscosity recited in the claims herein, it is noted that, it has been well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition, so long as the prior art discloses the same composition comprising the same ingredients in the same amounts as the instantly claimed.

Thus, Nadaud et al. anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Nadaud et al. in view of Hawley, G.G., The Condensed Chemical Dictionary, 10 Ed., Van Nostran Reinhold Co. New York, NY, 1981, page 423 (of record).

The same disclosure of Nadaud et al. as discussed above in the 102(b) rejection.

The prior art does not expressly disclose the employment of ethanol the cosmetic emulsion or composition of Nadaud et al.

Hawley teaches that ethanol is a common ingredient in cosmetics and acts as a solvent for fats and oils.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further employ ethanol with water in the cosmetic emulation or composition of Nadaud et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to further employ ethanol with water in the cosmetic emulation or composition of Nadaud et al. because ethanol is old and well known to be water-like solvent, being miscible with water, and a common ingredient in cosmetics and acts as a solvent for fats and oils as taught by Hawley. Thus, replacing some of water with ethanol is considered be conventional in the cosmetic art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,465,510.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts. Thus, these emulsion and cosmetic composition ~~between~~ in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-9 and 23-29 are seen to be obvious over the claims 1-13 of U.S. Patent No. 6,465,510.

Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,331,306.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts, and the same method or process of use the composition as instantly claimed. Thus, these emulsion and cosmetic composition and method ~~between~~ in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-29 are seen to be obvious over the claims 1-16 of U.S. Patent No. 6,331,306.

Claims 1-9 and 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,562,354.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts. Thus, these emulsion and cosmetic composition ~~between~~ in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-9 and 23-29 are seen to be obvious over the claims 1-34 of U.S. Patent No. 6,562,354.

Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,239,174.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition to skin comprising the same ingredients including the same emulsifier herein, dimethicone copolyol in the same amounts, and the same method or process of use the composition as instantly claimed. Thus, these emulsion and cosmetic composition and method ~~between~~ in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 1-29 are seen to be obvious over the claims 1-26 of U.S. Patent No. 6,239,174.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Anna Jiang, Ph.D.
Primary Examiner, AU 1617
September 21, 2004

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER